



25-42

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2823
Examiner: Fernando L. Toledo

In Re PATENT APPLICATION of:

Applicant(s): Masaru TAKAISHI
Serial No.: 10/766,212
Filed: January 29, 2004
For: METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE
Atty. ref.: AI 325

**REQUEST TO
WITHDRAW THE
FINALITY OF THE
ACTION AND
PROVISIONAL PETITION**

March 15, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the finality of the Examiner's Action dated March 6, 2006, be withdrawn and the period for response restarted, because Applicant has not amended claim 1 in a manner which would have necessitated the new grounds of rejection.

In the prior (and first mailed) Examiner's Action dated July 26, 2005, the Examiner rejected independent claim 1, and dependent claim 8 (as well as other claims) as being anticipated by Hsu et al. (USP 6,143,645).

In Applicant's response filed December 14, 2005, Applicants amended independent claim 1 to include only the subject matter of dependent claim 8, there being no intervening claims. This amendment did not change the scope of original claim 8 in any manner. That is, amended claim 1 had (and has) exactly the same scope as original dependent claim 8. Applicant also argued the allowability of this claim over the cited reference.

In response, the Examiner undertook a new search, and issued a second, final office action on March 6, 2006. In this second, final office action, the Examiner withdrew the previous rejections, and rejected claim 1 (as well as other claims) in view of the previously applied Hsu et al. patent in combination with the newly cited Hirao et

al. patent (USP 5,621,247). The Examiner's Action stated that Applicant's amendment necessitated the new grounds of rejection.

Applicant's counsel attempted to contact the Examiner on March 10, 2006, requesting that the finality of this action be withdrawn as being premature. Although a voice mail message was left for the Examiner, Counsel's phone call was not returned.

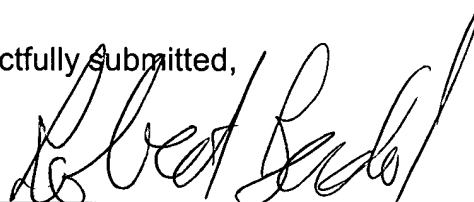
It is initially noted that the MPEP 706.07(a) states:

". . . [that a] second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Since Applicant has neither amended claim 1 in a manner that would necessitate a new ground of rejection (i.e., claim 1 now recites exactly the same subject matter as original claim 8), nor submitted any information disclosure statements, if the United States Patent and Trademark Office follows the guidelines set forth in the MPEP, then the Examiner's Final Action is improper. It is thus respectfully submitted that the present Action constitutes a premature final action and it is requested that the finality of this Action be withdrawn, and that the period for response be restarted.

Should the Examiner maintain the finality of this Action, it is requested that this request be considered a Petition to the Commissioner to exercise his supervisory authority, and withdraw the finality of the Action. It is not believed that any fee is due for such a Petition. However, authorization is given to charge our deposit account number 18-0002 for any fees that may be due for such Petition.

Respectfully submitted,



March 15, 2006
Date

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RHB/vm

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